

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Murrer III, A.A.
Title: TRANSPORT CONTAINER FOR
HAZARDOUS MATERIAL
Patent No.: 7,775,388
Issue Date: 08/17/2010
Appl. No.: 10/629,322
Filing Date: 07/28/2003
Art Unit: 3781
Confirmation Number: 6587

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. §1.705

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants have calculated PTA for the captioned patent and have determined that the patent is entitled to 1,802 days of Patent Term Adjustment, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702, 1.703 and 1.704:

(a) Total PTO delay: 1895 days

(b) Total Applicant delay: 93 days

Final PTA Determination under 37 CFR §1.703(f): 1802 days

In accordance with 37 C.F.R. 1.705(d) and 37 C.F.R. 1.705(b)(2)(ii), the basis for this Petition under 37 C.F.R. 1.702 and the relevant dates as specified in §§1.703(a) through (e) for which an adjustment is sought and the adjustment as specified in § 1.703(f) to which the patent is entitled are clearly represented in the attached PTA Calculation and the arguments set forth below.

In accordance with §1.705(b)(2)(iv)(A), the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704 are clearly represented in the attached PTA Calculation.

The patent is not subject to a terminal disclaimer.

The fee of \$200.00 required Under 37 C.F.R. § 1.18(e) is being paid by credit card via EFS-Web.

Legal Entitlement To Patent Term Adjustment Resulting From Appellate Review

In relevant part, 37 C.F.R. § 1.701 states:

(3) The period of delay under paragraph (a)(3) of this section is the sum of the number of days, if any, in the period beginning on the date on which an appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and ending on the date of a final decision in favor of the applicant by the Board of Patent Appeals and Interferences [].

37 C.F.R. § 1.701(c)(3).

On the issue of the patent term adjustment attributable as a result of appellate delay, 37 C.F.R. § 1.702 states:

(e) *Delays caused by successful appellate review.* Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to review by the Board of Patent Appeals and Interferences under 35 U.S.C. 134 [], if the patent was issued under a decision in the review reversing an adverse determination of patentability.

37 C.F.R. § 1.702(e).

Statement Of Facts And Analysis Relating To Appellate Review

In its PTA calculation, it appears that the Office has incorrectly calculated the PTO delay under 37 C.F.R. §§ 1.701 and 1.702(e) by not crediting the full period of appellate review. The relevant facts are set forth below.

(i) The final rejection of claims 17-19 was appealed on August 7, 2006: Claims 17-19 were finally rejected in the Office Action mailed May 5, 2006. Applicants filed a Notice of

Appeal on August 7, 2006, appealing the final rejection of all pending claims including claims 17-19.

(ii) The Examiner's final rejection of claims 17-19 was not affirmed by the Board of Patent Appeals and Interferences:

(a) The Decision on Appeal initially (but incorrectly) identified the Examiner's rejection of claims 17-19 as affirmed: The Board of Patent Appeals and Interferences ("BPAI") entered the Decision on Appeal on September 30, 2008. The Decision affirmed all rejections, including the rejection of claims 17-19. Decision at pages 20-23 and 25. The impropriety of this affirmation was successfully argued by Applicant.

(b) Applicant (successfully) argued that the BPAI asserted a new ground of rejection and did not affirm the Examiner's rejection of claims 17-19: In response to the Decision on Appeal, Applicant filed a Request for Rehearing on December 1, 2008 arguing, *inter alia*, that the BPAI's reasoning for maintaining the obviousness rejection of claims 17-19 were different from the reasons set forth by the Examiner. Request for Rehearing at pages 13-15. Specifically, Applicant argued that the reasoning provided in the Decision when affirming the rejection of claims 17-19 represented a new ground of rejection against which Applicant had not had an opportunity to present evidence of non-obviousness. Applicant further argued that this new ground of rejection did not affirm the Examiner's final rejection of record nor could this rejection properly be made final.

(c) The BPAI reversed the finality of the new rejection of claims 17-19 and did not affirm the Examiner's final rejection: On January 23, 2009, the BPAI entered the Decision on Request for Rehearing ("Rehearing Decision"). The Rehearing Decision addressed the question of whether the Board entered a new ground of rejection against claims 17-19. Specifically, the BPAI answered the question:

Did our analysis of the rejection of claim 17-19 under 35 U.S.C. § 103 as unpatentable over the combination of Redzisz, Zeddies, and Travis result in a new ground of rejection?

Rehearing Decision at page 12.

To which the BPAI answered in the affirmative.

Our analysis of the rejection of claims 17-19 under 35 U.S.C. § 103 as unpatentable over the combination of Redzisz, Zeddies, and Travis resulted in a new ground of rejection.

Rehearing Decision at page 14.

Thus, the outcome of the Rehearing Decision was to affirm the Examiner's rejections of all claims except claims 17-19 and to acknowledge that the BPAI had asserted a new ground of rejection against claims 17-19 in place of the appealed rejection. Rehearing Decision at page 14. This acknowledgement by the BPAI tacitly *reversed* the Examiner's final rejection of these claims. Therefore, the Rehearing Decision on claims 17-19 represents a successful appellate review in favor of Applicant.

(iii) Summary: Applicant respectfully requests a recalculation by the Office of the patent term adjustment in the above-captioned case. Specifically, it appears that the Office has failed to account for the delay arising from Applicant's successful appeal which reversed an adverse determination of patentability asserted by the Examiner. As discussed in detail above, the final rejection of claims 17-19 was not affirmed by the BPAI and therefore tacitly reversed. This reversal entitles Applicant to recover, as patent term adjustment, the delay caused by appellate review.

Conclusion

For the reasons set forth above, Applicants respectfully request that the patent be accorded a total of 1802 days PTA.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. § 1.705, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

However, because this PTA error is due to a Patent Office error in interpreting and applying the PTA statute, a refund of the fee is respectfully requested.

Respectfully submitted,

Date

8/10/10

By



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Patent Term Adjustment Calculation System

Add a new event to this case

Docket Number: 034827-3101
Application Number: 10/629322
Patent Number: N/A

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Application Filing Date	07/28/2003	0		
	14 month From Application date	09/28/2004	428		
Edit Delete	Non-Final Office Action	11/16/2005	842	414	
	Non-Final Office Action + 3 months	02/16/2006	934		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	02/17/2006	935		1
Edit Delete	Final Office Action	05/05/2006	1,012		
	3 Year Period Starts	07/28/2006	1,096		
	Final Office Action + 3 months	08/05/2006	1,104		
	3 Year Period Paused	08/06/2006	1,105		
Edit Delete	Notice of Appeal Received at PTO	08/07/2006	1,106		2
Edit Delete	Appeal Brief Received at PTO	11/20/2006	1,211		
Edit Delete	Appeal Brief Received at PTO	01/04/2007	1,256		
	Appeal Brief Filed + 4 months	03/20/2007	1,331		
Edit Delete	Examiner's Answer Mailed	03/29/2007	1,340	(9)	
Edit Delete	Reply Brief Received at PTO	05/24/2007	1,396		
Edit Delete	Final Office Action	05/07/2009	2,110		
Edit Delete	Final Office Action Response Received at PTO	06/23/2009	2,157		
Edit Delete	Advisory Action	07/01/2009	2,166		
Edit Delete	Final Office Action Response Received at PTO	07/15/2009	2,179		
Edit Delete	Non-Final Office Action	07/30/2009	2,194		
	Non-Final Office Action + 3 months	10/30/2009	2,286		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	01/28/2010	2,378		90
Edit Delete	Final Office Action	05/10/2010	2,478		
Edit Delete	Final Office Action Response Received at PTO	05/18/2010	2,486		

Edit Delete	Notice of Allowance	06/11/2010	2,510		
Edit Delete	Issue Fee Paid	07/02/2010	2,531		
Edit Delete	Patent Grant Date	08/17/2010	2,577	1481	
Totals:				1,895	93
PTA:				1,802	
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